

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. WGN-3824-4

HENLEY

C# M#

Serial No. 09/725,142

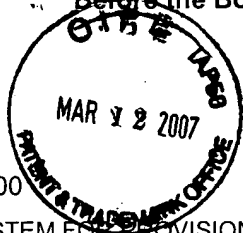
TC/A.U.: 3624

Filed: November 29, 2000

Examiner: S. Karmis

Date: March 12, 2007

Title: METHOD AND SYSTEM FOR PROVISION
AND ACQUISITION OF MEDICAL SERVICES AND PRODUCTS



W
AP

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences

from the last decision of the Examiner twice/finally rejecting \$500.00 (1401)/\$250.00 (2401) \$
applicant's claim(s).

☐ An appeal **BRIEF** is attached in the pending appeal of the \$500.00 (1402)/\$250.00 (2402) \$
above-identified application

☐ Credit for fees paid in prior appeal without decision on merits -\$ ()

☒ **A REPLY BRIEF IS ATTACHED.** (no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)
One Month Extension \$120.00 (1251)/\$60.00 (2251)
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on -\$ ()

TOTAL FEE ENCLOSED \$ 0.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or
asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this
firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: William G. Niessen, Reg. No. 29,683

Signature:

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HENLEY

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For: METHOD AND SYSTEM FOR PROVISION OF MEDICAL SERVICES AND
PRODUCTS



Atty. Ref.: 3824-4

Group: 3691

Examiner: Karmis, S.

Before the Board of Patent Appeals and Interferences

**REPLY BRIEF FOR APPELLANT
On Appeal From Final Rejection
From Group Art Unit 3691**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

HENLEY

Serial No. 09/725,142

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REPLY BRIEF

Sir:

Appellant submits this Reply Brief in response to the Examiner's Answer of January 12, 2007.

Appellant will not repeat in detail herein the arguments set forth in the Appeal Brief filed September 19, 2006 (which is incorporated herein by reference), but instead will briefly respond below to certain assertions set forth in the Examiner's Answer in order to complete the record for appeal.

- A. The Rejection of claims 1-9, 12-17, 21 and 30-35 under 35 U.S.C. § 103(a) over DiRienzo in view of Newman

Regarding applicants' claim 1, the Examiner contends that "In the simplest interpretation of claim 1, DiRienzo teaches *authenticating qualifications of said medical*

service provider to perform a proffered medical service in that a physician logs on to the RAMIX system to access their Provider Mail Box by entering a security code, then the physician can look for images waiting to be read (column 23, lines 28-32). It is inherent that authenticating the username/password would be done automatically.” (See Answer at pg. 13, lines 10-15). This contention lacks merit because DiRienzo’s procedure of granting a physician provider access to the RAMIX system upon entry of an authenticated security code (e.g., username/password) is clearly not the same as applicants’ claimed process of authenticating the qualifications of a medical service provider (after obtaining registration information from the provider) e.g., before issuing an access password if, indeed, password access is permitted in the system design. Applicants’ process of automatically authenticating qualifications involves utilizing a search engine to research a provider in one or more official “qualifier databases” that contain authentic certification data of medical service providers (e.g., official databases maintained by the AMA or a state’s medical licensing board) and verifying that the particular provider is officially certified or sanctioned to provide a proffered medical service. (See, for example, applicants’ specification at page 20, lines 17 et seq.)

Contrary to the Examiner’s above stated position, an adoption of even the broadest interpretation of “authenticating qualifications” in applicants’ claim 1, requires more than DiRienzo’s merely accessing a database in which the provider is registered to see a list of jobs available to that provider (Answer at page 12, lines 1-4). Moreover, DiRienzo’s password security for ensuring that a physician is a registered participant (Answer at pg.

13, lines 2-4) does not itself serve to authenticate a physician's proffered qualifications to perform a particular medical service.

The Examiner contends that "DiRienzo also teaches authenticating qualifications through the clearing house computer (CHC)..." (see Answer at pg. 13, lines 17-20). This contention is also without merit. DiRienzo's "clearing house computer" (200 in Fig. 3 of '919 patent) is a computer system used for storing digitized patient images, Patient Bid Queues and Provider Mail Boxes -- but it does not contain or provide access to official certification data of medical service providers. Likewise, DiRienzo's obtaining and providing access to biographical information of a physician, including medical schools attended or affiliations (see Answer at pg. 14, lines 3-6), is clearly not authenticating qualifications of that provider to perform a proffered medical service, as set forth in applicants' claim 1.

Regarding applicants' claim 1, the Examiner also contends that Newman '276 "teaches a medical practitioner credentialing system ... for physicians who must have their credentials verified for application forms" (see Answer at pg. 14, lines 11-14). However, the Examiner apparently fails to recognize that Newman system only stores a common set of provider "credentialing information" for use in automatically generating a plurality of different provider application forms having different formats. Newman '276 does not teach automatically performing authentication (verification) of a particular provider's qualifications, but rather only causes a universal provider profile form to be completed and delivered to a third party "credentialing managing organization" which is

HENLEY
Serial No. 09/725,142
March 12, 2007

responsible for maintaining the provider's "credentialing information" and independently performing verification with respect to that information. (See '276 Newman et al. patent at col. 1, lines 37-51 and col. 3, lines 36-67.)

The Examiner contends that "there is sufficient motivation to combine the analogous teachings of DiRienzo and Newman" (see Answer at pg. 16, lines 3-4). The Examiner's reasoning has no support in the cited art at least because neither reference discloses or suggests automatic verification of a physician's credentials. (See appellant's Appeal Brief at page 27, lines 6 et seq.)

Regarding applicants' claim 21, with respect to the Examiner's contentions that DiRienzo in view of Newman teaches "automatically accessing a maintained database and/or one or more online commercial data resources to obtain information describing the health and/or financial condition of a bid-submitting prospective patient" (Answer at pg. 16), neither DiRienzo nor Newman teach *automatically* accessing the maintained database *in response to receiving a bid*, as set forth in claim 21. Moreover, applicants' claim 21 also requires at least "forwarding a received online bid to an associated medical service provider together with the information describing the health and/or financial condition of the prospective patient associated with said forwarded bid". Although DiRienzo discloses placing a patient's image information in a Clearinghouse Computer (CHC) where it may be accessed by a physician, neither DiRienzo nor Newman teach forwarding a received online bid together with information describing the health and/or financial condition of the prospective patient/chart to an associated medical service

provider. DiRienzo's RAMIX system requires that the physician access a particular bid in a PBQ or PMB area on the Clearinghouse Computer then download a particular image if they decide to accept the bid and do a reading. (See '191 patent at col. 14, lines 30-34.)

Regarding applicants' claim 30, the Examiner contends that "Appellant only states that the steps are performed by the computer in the preamble of the claim" and that "Appellant does not distinguish which limitations in the body of the claim are preformed by the computer" (see Answer, middle of page 17). However, the Federal Circuit has mandated an analysis to determine whether the preamble is to be given weight. The Examiner simply dismisses the preambles as intended use. But the central Federal Circuit test requires determining whether "the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed. Cir. 1999). Indeed, "a claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc., v. Vitalink Communications Corp., 55 F.3d 615, 620 (Fed. Cir. 1995).

The preamble of claim 30 recites: "A *computerized method* for selling a qualified personal medical service selected from a menu of authenticated qualified personal medical services, the menu of authenticated qualified medical services being accessible to prospective buyers of personal medical services, comprising the steps *performed by a computer* of: " (emphasis added). The preamble of claim 30 clearly requires a

“computerized method” and “steps performed by a computer.” It therefore provides the context for the steps recited in the balance or body of claim 30 and, when read in the context of the entire claim, recites a limitation of the claim that must be given patentable weight.

Regarding applicants’ claim 35, the Examiner states “it is noted that the features upon which applicant relies, discussed above are not recited in the claim 35. Claim 35 has no mention of ‘establishing a computer readable medical service provider identification code.’...” (see Answer top of page 18). This statement is incorrect. Applicants’ claim 35, as amended in applicants’ March 23, 2006 Response/Amendment and reproduced in applicants’ Appeal Brief at page 39, includes all of the features relied upon in the Brief. The Examiner and members of the Board are respectfully directed to see Applicants’ Brief at pages 39 and 40 in paragraph (d) and paragraph (e), sub-paragraphs (i) and (ii) of claim 35.

With respect to the Examiner’s new introduction and discussion of Kenna ‘641 (in response to Appellant’s challenge to the Official Notice taken by the Examiner in rejecting claims 5, 8 and 9), applicants contend that this reference is misapplied and without merit for demonstrating that determining a price based on the specific factors set forth in claims 5, 8 and 9 are old and well known. The Integrated Nested Account Financial System disclosed by Kenna et al. relates to a computerized financial account management system that includes master and sub-accounts where one sub-account is a Medical Savings Account. However, Kenna ‘641 does not teach or suggest the posting

online of associated specifications concerning a proffered service that includes terms of payment (such as, for example, a partial advance payment) for performing the proffered service, as required by applicants' claims 2 and 3 from which rejected claims 5, 8 and 9 depend.

With respect to the Examiner's new introduction and discussion of Ilsen '898 (in response to Appellant's challenge to the Official Notice taken by the Examiner in rejecting claims 13 and 14), applicants contend that the use of CPT and ICD-9 codes by Ilsen '898 in the disclosed patient/provider communications interface does not teach or suggest providing CPT or ICD-9 codes for use in selecting proffered medical services online or including associated CPT or ICD-9 codes in an online posting of particular proffered medical service, as set forth in applicants' claims 13 and 14.

B. The Rejection of claims 10, 11 and 50-57 under 35 U.S.C. § 103(a) over DiRienzo in view of Newman in further view of Feinberg

The Board is respectfully directed to Appellant's Brief with respect to the Examiner's rejection of applicants' claims 10, 11 and 54-57. In regard to applicants' claims 50-53, the Examiner's application of Feinberg as teaching "a bidding system in which information on seller transactions, comments from buyers and other information about the seller" is without merit at least because claims 50-53 are directed toward feedback information from a *service provider* about a particular *patient's* compliance after having received treatment and the treatment outcome — i.e., not comments from a buyer about a seller or service provider.

C. The Rejection of claims 58-60 under 35 U.S.C. § 103(a) over DiRienzo in
view of Newman in further view of Rackson

The Examiner's contention that "Rackson teaches computing an adjusted bid price based on certain factors considered during a service transaction" (see Answer at page 21) is without merit. Applicants claims 58-60 require computing of an adjusted bid price *based on a relative value multiplier to a CPT code Relative Value Scale* if it is determined that after a bid price acceptance a different or altered procedure or service must be performed. There is no teaching or suggestion in Rackson of adjusting a bid price based on a relative value multiplier to a CPT code Relative Value Scale. The Examiner's assumption that the claimed basis for adjusting a bid price would have been obvious is impermissible hindsight.

For at least the above reasons, it is respectfully requested that the Board reverse all outstanding rejections.

Respectfully submitted,

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